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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/357,423	07/20/1999	THOMAS M. BAER	17726-726	9233
34690	7590	05/24/2006	EXAMINER	
RIMAS LUKAS 2707 18TH STREET SAN FRANCISCO, CA 94110			CROSS, LATOYA I	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 05/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/357,423

Applicant(s)

BAER, THOMAS M.

Examiner

LaToya C. Younger

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 25-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,4,25-37,39-42,46-50 and 52 is/are allowed.
- 6) ☒ Claim(s) 1,2,38,43-45,51,53 and 54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is in response to Applicants' remarks filed on January 23, 2006. Claims 1-4 and 25-54 are pending.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 38, 43-45, 51, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mansour (US 6,057,165) in view of US patent 6,720,191 to Goldstein et al.

Mansour discloses an assay device for collecting and testing biological samples. The device comprises a base (45) having a composite material (41) onto which a biological sample is disposed. The base having the biological sample is considered to be a "carrier". The carrier mates with a cover portion (46). The cover portion has an aperture (48), which is a conduit running from the top of the cover to the bottom of the cover. When the cover is mounted onto the base, the sample carrier closes the bottom part of the conduit and forms a reservoir (47). There are portions of the carrier on both sides of the conduit that are not in communication with the conduit. A part of the cover covers a portion of the carrier and excludes a part of the carrier from being in communication with the conduit. See figure 5, where a portion of the composite material (41) lies outside of the reservoir (47). Mansour further discloses that a well (10) may be mated with cover at the conduit for delivering fluids into the conduit (col. 12, lines 1-7).

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Mansour differs from the instant invention in that the amended claims recite that the carrier closes the first opening so that fluid flow is prevented through the bottom surface of the carrier. Mansour discloses an absorbent multi-layered carrier that would allow flow through the absorbent layers. However, Goldstein et al teach pressure adhesive tapes for use in laser capture microdissection. The tape collects a tissue sample and is subjected to activation by a pulsating laser beam causing the adhesive to flow around the tissue sample and adhere the sample to itself. Further processing and analysis of the sample follows. Goldstein et al teach an alternative carrier to the absorbent carrier disclosed in Mansour. It would have been obvious to one of ordinary skill in the art to incorporate the pressure-sensitive adhesive carrier into the carrier receiving device of Mansour to provides a means of capturing and analyzing a different type of sample (such as a solid sample) that would not be possible with the absorbent carrier disclosed by Mansour. Such modification would involve mere substitution of one known type of carrier for another known type of carrier, as discussed in MPEP 2144.07.

#### *Response to Arguments*

3. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

#### *Allowable Subject Matter*

4. Claims 3, 4, 25-37, 39-42, 46-50 and 52 are allowed for the reasons set forth in the previous Office Action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya C. Younger whose telephone number is 571-272-1256. The examiner can normally be reached on Monday-Thursday 10:30 a.m. - 8:00 p.m. and on alternating Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700